



# UNITED STATES PATENT AND TRADEMARK OFFICE

7  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,276	06/21/2005	Anna Ingrid Kristina Berggren	100939-1P US	8864
52286	7590	08/10/2006	EXAMINER	
COZEN O'CONNOR, P.C. 1900 MARKET STREET PHILADELPHIA, PA 19380			YOUNG, SHAWQUIA	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/540,276

Applicant(s)

BERGGREN ET AL.

Examiner

Shawquia Young

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14, 16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 14, 19-21 (in-part), 16 and 18 (whole) is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14, 19 and 21 is/are rejected.
- 7) ☒ Claim(s) 12 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/21/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

Claims 1-12, 14, 16, and 18-21 are currently pending in the instant application.

### **I. *Priority***

The instant application is a 371 of PCT/GB03/05569, filed on December 18, 2003, which claims benefit of the Foreign Application UNITED KINGDOM 0230088.7, filed on December 24, 2002.

### **II. *Information Disclosure Statement***

The information disclosure statement (IDS) submitted on June 21, 2005 is in partial compliance with the provisions of 37 CFR 1.97 because of missing copies of references listed under the Foreign Patent Documents and the Non Patent Literature Documents sections. Accordingly, the information disclosure statement in-part has been considered by the examiner.

### **III. *Restriction/Election***

#### **A. *Election: Applicant's Response***

Applicants' election with traverse of Group I in the reply filed on July 17, 2006 is acknowledged. The traversal is on the ground(s) that: (1) the Examiner has not met the *prima facie* burden in the restriction requirement sent out July 3, 2006; and (2) Groups I and II have been classified in identical classes (class 548), thus indicating a lack of serious burden.

All of the Applicants' arguments have been considered but have not been found persuasive. It is pointed out that the restriction requirement is made under 35 U.S.C.

Art Unit: 1626

121 and 372. 35 U.S.C. 121 gives the Commissioner (Director) the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted the claimed subject matter accordingly.

Applicants argue that the Examiner has not met the *prima facie* burden in the restriction requirement. Applicants further discuss that the Examiner has not shown separate status in the art or a requirement for a different field of search. The Examiner points out that the instant application is a 371 and is examined under PCT Rule 13.1 and 13.2. In the Office action (page 5, lines 11-13), the Examiner has stated that the claims of the instant application lack unity of invention because the special technical feature does not define a contribution over the prior art. The Examiner further points out that the R<sup>1</sup> variable is defined in claim 1 as phenyl, thienyl, or pyridyl. The R<sup>1</sup> variable can control the classification for the compounds which means that each cyclic group could result in a different class or subclass. Therefore different search considerations are involved (i.e., class/subclass searches, databases searches, etc.) for each of the groups listed. The different inventions of the instant application belong to the following classes: 514, 546, and 548. However, each Class 514, 546 and 548 encompasses numerous patents and published applications. For instance, Class 514 contained 165,171 patents and published applications. Therefore it would constitute a burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety.

Applicants argue that Groups I and II of the instant application are classified in the same class (class 548) and should be examined in the present application without restriction. In view of applicants argument, the Examiner has examined both Groups I and II without restriction.

Subject matter not encompassed by elected Groups I and II are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

#### **IV. Rejections**

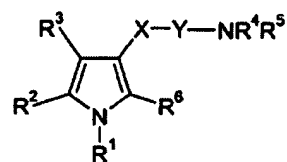
##### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

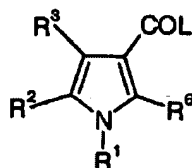
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11, 14, 19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by *Smith, et al.* (US20040267028, 2004). The primary reference of *Smith, et al.* claims benefit to a Provisional application 60/324, 441, filed on September 24, 2001.



The instant invention claims a product with the formula

in claim



1 and a product with the formula

in claim 19.

The *Smith, et al.* reference teaches the preparation and use of pyrrole derivatives such as 1-(2-chlorophenyl)-5-(4-methoxyphenyl)-2-methyl-N-(1-piperidinyl)-1H-pyrrole-3-carboxamide (See example 4, page 7). This species of compound anticipates the genus compound of the instant invention wherein the genus structure is displayed above and is fully defined in claim 1 of the instant application.

The above primary reference also teaches the pyrrole intermediates used in the preparation of the pyrrole-3-carboxamide derivatives such as 1-(2-chlorophenyl)-5-(4-methoxyphenyl)-2-methyl-1H-pyrrole-3-carboxylic acid (See example 4, page 7, paragraph [0112]). This species of compound anticipates the genus compound of the instant invention that is fully defined in claim 19.

## V. Objections

### **Specification**

Applicant is reminded of the proper language and format for an abstract of the disclosure.

Art Unit: 1626

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

#### **Claim Objection-Non Elected Subject Matter**

Claims 1-12, 14, and 19-21 are objected to as containing non-elected subject matter. To overcome this objection, Applicant should submit an amendment deleting the non-elected subject matter.

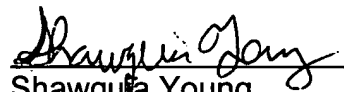
### **VI. Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

Art Unit: 1626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>o</sup>Kane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shawqufa Young  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600



Joseph M<sup>o</sup>Kane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600